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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,671	07/28/2003	Ulrich Sander	33997.0087	7114
26712	7590	08/02/2005	EXAMINER	
HODGSON RUSS LLP ONE M & T PLAZA SUITE 2000 BUFFALO, NY 14203-2391			FINEMAN, LEE A	
		ART UNIT		PAPER NUMBER
				2872

DATE MAILED: 08/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/628,671	SANDER, ULRICH	
	Examiner	Art Unit	
	Lee Fineman	2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 20 May 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-13 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 7/28/04 & 5/20/05 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

This Office Action is in response to an amendment filed 20 May 2005 in which claims 1, 5 and 6 were amended. Claims 1-13 are pending.

Drawings

1. A replacement drawing was received on 20 May 2005. This drawing is acceptable.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Klein, U.S. Patent No. 4,361,379.

Klein discloses an objective for a microscope (figs. 4-6), the objective comprising: an optical axis (vertical dashed line, figs. 4-6); a first objective part for observation (left side of 26 or 33); and a second objective part for illumination (right side of 26 or 33), the second objective part being separated from the first objective part (figs. 4-6) and having an illumination axis passing therethrough (figs. 4-6, dashed line to the right of cover plate), wherein the illumination axis extends at an angle to the optical axis of the objective (dashed line to the right of cover plate

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is at an angle to the vertical optical axis, figs. 4-6); wherein the first objective part and the second objective part are complementary parts (fig. 4-6); wherein deviations in an optical correction between the a first objective part for observation and the second objective part for illumination are corrected at least in part by way of modified air gaps (in so far as the air gap between lens element 26 and 27 or 33 and 34 are modified during focusing which is an optical correction).

4. Claims 1-2, 5, 7, 10-11 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Strähle, U.S. Patent No. 6,392,797 B2.

Regarding claims 1-2, 5, 7 and 13, Strähle discloses in fig. 1 an objective for a microscope, the objective comprising: an optical axis (7); a first objective part for observation (27); and a second objective part for illumination (15), the second objective part being separated from the first objective part (fig. 1) and having an illumination axis (11) and having an illumination axis passing therethrough (fig. 1), wherein the illumination axis extends at an angle to the optical axis of the objective (fig. 1); wherein the first objective part and the second objective part are complementary parts (in so far as the two parts serve to fill out or complete the matching of the illumination and object fields, see column 3, lines 11-23); a front lens element group (25) and a deflection element (33) mounted directly above the front lens element group (fig. 1) for coupling an illumination beam path (17 and 19) into a beam path of the microscope; wherein deviations in an optical correction between the a first objective part for observation and the second objective part for illumination are corrected at least in part by way of modified air gaps (column 3, lines 1-37); wherein the first objective part (27) includes optical elements displaceable along the optical axis (7) of the objective and the second objective part (15)

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includes optical elements displaceable along the illumination axis (11) and correlated to the displaceable optical elements of the first objective part, and wherein a change in position of the displaceable optical elements of the first objective part results in a change in position of the correlated displaceable optical elements of the second objective part (column 3, lines 1-37); and wherein the separation of the first and second objective parts deviates from bisection (fig. 1, 27 is larger than 15).

Regarding claims 10-11, Strähle discloses in fig. 2 a front lens element group (25) having a first front lens element group part on an observation beam path (right side of dashed element) and a second front lens element group part on an illumination beam path (left side of dashed element), and means for optically decoupling the second front lens element group from the observation beam path (dashed element, column 3, lines 38-43), which is a cover.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strähle.

Strähle discloses the claimed invention except for explicitly stating that the coupling (30) of the displaceable optical elements of the first objective part and the second objective part are mechanically coupled or electro-mechanically coupled. Official Notice is taken that mechanically coupled or electro-mechanically coupled lens elements are very well known in the

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art for accurate, synchronized movement of lenses. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the coupling of Strähle be either mechanically coupled or electro-mechanically coupled to provide for accurate, synchronized movement of the objective lens parts.

It is noted as directed by the MPEP 2144.03 that if the applicant does not seasonably traverse the well-known statement during examination, then the object of the well-known statement is taken to be admitted prior art. *In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). As such, the above official notice statement of the examiner is now held to be admitted prior art.

7. Claims 3-4, 6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strähle in view of Ishikawa et al., U.S. Patent No. 4,871,245.

Strähle further discloses a deflection surface that is convexly curved surface (241, fig. 4). Strähle discloses the claimed invention except for the deflection element including an entrance surface, a deflection surface, and an exit surface, and at least one of the entrance, deflection and exit surfaces is a concavely curved surface; and wherein the second front lens element group part is associated with the second objective part, and the objective further comprises a deflection element arranged such that an exit surface of the deflection element is coplanar with a surface of the first front lens element group part. Ishikawa et al. disclose a microscope (figs. 4 and 6) with a deflection element (49, 70) for directing illumination light and including an entrance surface, a deflection surface, and an exit surface, and at least one of the entrance, deflection and exit surfaces is a concavely curved surface (fig. 4). It would have been obvious to one of ordinary

skill in the art at the time the invention was made to replace the deflection element of Strähle with that of Ishikawa et al. to provide more flexibility by having more surfaces for different surface combinations for specific beam directing. Therefore, regarding claim 12, the second front lens element group part (left side of dashed element in fig. 2) is associated with the second objective part (15), and the objective further comprises a deflection element (70, Ishikawa) arranged such that an exit surface of the deflection element is coplanar with a surface of the first front lens element group part (fig. 1, in so far as the exit surface of a prism element as 33 is coplanar with the top surface of element 25).

Response to Arguments

8. Applicant's arguments filed 20 May 2005 have been fully considered but they are not persuasive.

Applicant argues in page 8, paragraph 4 that Klein does not include an illumination axis passing through the second objective part. The examiner respectfully disagrees. The illumination axis continues after deflection off of element 8 and passing through the second objective part. As further evidence, see fig. 2, ray 16 which is detailed in column 2, lines 65-66 as "the illumination rays with optical axis 16."

Applicant further argues that Strähle does not disclose complementary parts of an objective because the first and second objective parts do not have matching lens element portions (page 9, paragraph 2). The examiner respectfully disagrees. There is no special definition of complementary in the specification. Therefore, the definition of complementary is taken to serving to fill out or complete as detailed in Merriam-Webster's Collegiate Dictionary, Tenth

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Edition. The first and second objective parts of Strähle are complementary as the two parts serve to fill out or complete the matching of the illumination and object fields, see column 3, lines 11-23.

Finally, the applicant states on page 9, paragraph 7, that the examiner's statement that "the objective further comprises a deflection element (70, Ishikawa) arranged such that an exit surface of the deflection element is coplanar with a surface of the first front lens element group part (fig. 1, in so far as the exit surface of a prism element as 33 is coplanar with the top surface of element 25)" is incorrect because Strähle is a mirror not a prism. The examiner would like to point out that the statement was made to the combination of the prism deflection element (70) of Ishikawa being used as element 33 in the system of Strähle.

9. It is noted by the Examiner that the drawing and claim objections made in the previous Office Action have been withdrawn due to amendment by the Applicant.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee Fineman whose telephone number is (571) 272-2313. The examiner can normally be reached on Monday - Friday 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



LAF

July 25, 2005



MARK A. ROBINSON
PRIMARY EXAMINER